



12 JUN 2007

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In re Application of:
SIMCHA et al.
U.S. Application No.: 10/532,112
PCT No.: PCT/IL03/00952
International Filing Date: 12 November 2003
Priority Date: 12 November 2002
Attorney's Docket No.: 3073/8
For: METHOD OF LEACHING BERYLLIUM
FROM BERYLLIUM-CONTAINING ORES
USING FLUOSILICIC ACID

DECISION ON PETITION

This decision is issued in response to applicants' "Petition to Withdraw Holding of Abandonment" filed 28 April 2006, which is being treated as petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 12 November 2003, applicants filed international application PCT/IL03/00952 which claimed a priority date of 12 November 2002 and which designated the United States. On 27 May 2004, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB"). The deadline for payment of the basic national fee was thirty months from the priority date, i.e., 12 May 2005.

On 21 April 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a copy of the international application, and a declaration executed by three of the four inventors. The declaration included an unsigned signature block for the remaining inventor, Simcha Harel.

On 15 September 2005, the United States Designated Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 15 December 2005, applicants filed "Completion of Filing Requirement" which stated "[t]his is to inform that the inventor Simcha Harel, whose signature is missing from the declaration, is deceased. We are currently acting to obtain the Death Certificate, and signature of his heir, and will forward them when available."

On 12 April 2006, the United States Elected Office mailed a Notification of Abandonment under 37 CFR 1.495 (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 15 September 2006 within the time period set therein.

On 28 April 2006, applicants filed the present "Petition to Withdraw Holding of Abandonment."

DISCUSSION

The above-identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 15 September 2005, in that, a declaration in compliance with 37 CFR 1.497(a)-(b) had not been submitted within the period set therein.

Applicants' 15 December 2005 communication (Completion of Filing Requirements) was not a proper reply to the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905). The communication stated that, "Simcha Harel, whose signature is missing from the declaration, is deceased. We are currently acting to obtain the Death Certificate, and signature of his heir . . ." In this case, a proper response must include a declaration in compliance with 37 CFR 1.42 and 37 CFR 1.497(a)-(b) executed by the legal representative of the deceased (or all of the heirs, if appropriate); or, if all of the required signatures cannot be obtained, a proper response must include a grantable petition under 37 CFR 1.47(a). See MPEP 409.01-409.03(h). Therefore, applicants have not filed the response required by the Code of Federal Regulations.

Because the failure to file the proper response does not appear to have been the result of an inadvertent omission (37 CFR 1.135(a)), applicants were not accorded a new time period to correct the deficiencies in the response. Accordingly, the application was held to be abandoned.

CONCLUSION

For the reasons above, the petition to withdraw the holding of abandonment under 37 CFR 1.181 is DISMISSED without prejudice. The application remains abandoned.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. A proper response must include an oath or declaration executed on behalf of the deceased inventor in compliance with 37 CFR 1.42 and including all the information required under 37 CFR 1.497 (for example, the names of all the inventors and the citizenship, mailing address, and residence information for **both** the deceased inventor and the legal representative, as discussed above).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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